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UNITED STATES PATENTS QUARTERLY

Ex parte RUBIN

No Number in Original

U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences

128 U.S.P.Q. (BNA) 440

Opinion dated Sept. 30, 1959

CASE HISTORY and DISPOSITION: Appeal from Primary Examiner.

Application for patent, Serial No. 513,642. From decision rejecting claims 1 to 9, applicant appeals. Appeal dismissed as to claims 1, 4, and 5; affirmed as to claims 2, 3, and 6 to 9.

HEADNOTES:
PATENTS

[**1H] 1. Affidavits -- Anticipating references (12.3)

Double patenting--In general (33.1)

If applicant's claims are rejected as not patentable over claims of his prior patent, a Rule 131 affidavit is ineffective, as only one patent can issue for a single inventive concept; if applicant's claims are patentably distinct over those of the patent, a Rule 131 affidavit would not be required; therefore, there is no need for Board to consider affidavit.

[**2H] 2. Abandonment--Disclosure without claiming (10.7)

Basic requisite for rejection on ground that applicant dedicated claimed method to the public is that what is claimed in application is disclosed but not claimed in applicant's patent.

[**3H] 3. Patentability -- Change -- In general (51.251)

Same product is obtained by either method claimed in application or that claimed in applicant's prior patent; no unexpected result is obtained by reversing order of steps recited in method claimed in patent; hence, method claimed in application is not patentable over patented method.

Particular patents--Coated Sheet

Rubin, Method of Manufacturing a Conductive Coated Sheet, claims 2, 3, and 6 to 9 of application refused.

CLASS-NO: 10.7, 12.3, 33.1, 51.251

COUNSEL: EZEKIEL WOLF, Boston, Mass., for applicant.

JUDGES: Before SURLE, Examiner in Chief, and MAGIL and WILES, Acting Examiners in Chief.

OPINIONBY: WILES, Acting Examiner in Chief.

OPINION:

This is an appeal from the final rejection of claims 1 to 9. Since claims 1, 4 and 5 were withdrawn from further consideration as not reading on the elected species, the appeal as to these claims will be dismissed, leaving for our consideration only claims 2, 3 and 6 to 9. No claims have been allowed. [*441]

Claims 2 and 9 are sufficiently representative and are reproduced below:

2. A method of manufacturing a plate or sheet having an electrical conductive non-alkali metallic plated coating which comprises taking a base sheet of flexible impregnable paper material, first impregnating the sheet from at least one side with a thermosetting resin and partially curing said resin in the sheet, then depositing a smooth highly-conductive metallic film of uniform thickness on the other side capable of being etched into a printed circuit, and then laminating the sheet to a backing sheet of thermosetting material and making the final cure of the assembly under heat and pressure.

9. A method of manufacturing a plate or sheet having an electrical conductive nonalkali metallic plated coating including the steps of taking a base sheet of flexible impregnable paper material and first impregnating the sheet from one side with a thermosetting resin, and the additional steps of depositing a smooth metallic film of uniform thickness and capable of being etched into a printed circuit on the other side of the base sheet, and laminating the sheet with the metallic coating and the resin to a backing sheet of thermosetting material, with the backing sheet on the side of the base sheet opposite the metallic film.

The references relied upon are:

Baekeland, 1,019,406, March 5, 1912.

Keller, 2,439,137, April 6, 1948.

Rubin, 2,680,699, June 8, 1954.

The claims are directed to a method of forming a laminated sheet, one surface of which is made of highly conductive material, which method is more fully described on pages 3 to 5 of appellant's brief.

The alleged invention of the instant application is best summarized by appellant on page 5 of his brief as relating "to a method of making a laminated sheet wherein a base sheet is first impregnated with a thermosetting material and thereafter coated with a metallic film."

The examiner has rejected the claims as unpatentable over Rubin as well as unpatentable over Keller in view of Baekeland.

Go to Headnotes [**1R] [1] As pointed out by appellant in his brief, the examiner several times seems to have considered appellant's patent as a publication, as he has rejected the appealed claims as unpatentable over the disclosure thereof, although in Paper No. 9, as well as in the statement, the rejection seems to be based upon the claims of the Rubin patent. The examiner has also expressed the view that a Rule 131 affidavit is ineffective for appellant to overcome his own patent if the present claims are unpatentable over the patent, and this view would imply, as more fully brought out by the examiner in answering appellant's arguments, that the basis for the rejection is the invention claimed in appellant's prior patent. In such a rejection if the appealed claims are not patentable over the claims of the patent, a Rule 131 affidavit obviously is ineffective, as only one patent can issue for a single inventive concept. However, if the claims herein are patentably distinct over those of the patent, a Rule 131 affidavit obviously would not be required. There is therefore no need to consider the Rule 131 affidavit.

Go to Headnotes [**2R] [2] The examiner in his refusal of the claims has included in his statement language indicative that he considers appellant to have dedicated to the public the method recited in the appealed claims. A basic requisite for a rejection on this ground is that what is claimed herein is disclosed but not claimed in appellant's patent. However,

the examiner has not even alleged that the sequence of steps required by the claims before us is disclosed in the patent, and we fail to find any such disclosure in the patent. In fact, the examiner's argument as to the non-criticality of the reversal of the order of steps of the present claims over those of the Rubin patent indicates the lack of any such unclaimed disclosure in the patent. It is obvious therefore that there is no basis for any "dedication" of the method claimed herein and hence the position of the examiner is untenable and cannot be sustained. *Ex parte Harman*, Patent File No. 2,520,280, 86 USPQ 487.

Go to Headnotes [**3R] [3] This leaves for our consideration the question of whether the method claimed herein is patentable over the method claimed in appellant's patent as only one patent can be granted if there be but one invention. The examiner has quite fully set forth his position in support of this rejection and answered appellant's arguments with respect thereto. We therefore find little need for any extended comments except to note that appellant has not attempted to refute the examiner's position that it is not inventive to change the order of steps. In fact, appellant concedes that the same product is obtained by either the method claimed herein or that claimed in the patent. Moreover, appellant, on page 6 of the brief, states that:

"The method described in the patent is considered the better of the two [*442] methods invented, but the method set forth in the instant case does perform satisfactorily."

It is evident therefore that no unexpected result is obtained by reversing the order of steps recited in the method claimed in the Rubin patent. *In re Haller et al.*, 24 CCPA 887, 1937 C.D. 281, 481 O.G. 6, 87 F.2d 520, 32 USPQ 306; *New Wrinkle, Inc., et al. v. Watson*, 1953 C.D. 18, 670 O.G. 306, 204 F.2d 35, 96 USPQ 436, 438. Accordingly, we agree with the examiner that the method recited in the appealed claims is not patentable over appellant's patented method and we will sustain the rejection.

The examiner has also rejected the claimed method as unpatentable over Keller in view of Baekeland, his position being as follows:

"Keller discloses impregnating a fibrous sheet with thermosetting resin and spraying a highly conductive metal on one or both sides of the sheet and laminating this to another similar resin impregnated sheet under heat and pressure. The Baekeland reference is used to show that curing a resin in several stages is old in the art. Partially curing the resin of Keller before the metal layer has been deposited is considered an obvious modification of Keller's process of curing. No invention is seen in applying a metal film of uniform thickness instead of the irregular thickness as in Keller since to do so would be mere mechanical expedient. Nowhere does applicant show the criticality of this step or that any new and unobvious result would be accomplished by coating the metal uniformly instead of non-uniformly."

While Keller discloses that the metal coating may be on one or both sides of the sheet, we find no disclosure therein which even suggests, when only one side is metallized, that the other side is to be impregnated with the thermosetting resin and that the impregnated side may then be laminated to a backing sheet of thermosetting material. Additionally, in the process of Keller it is the metallized face or side of the sheet which is laminated to a resinous material and results in a product which would not be suitable for appellant's purpose. We therefore are constrained to agree with appellant that the procedure of Keller is not suggestive of the claimed method and the rejection will not be sustained.

The appeal is dismissed as to claims 1, 4 and 5.

The decision of the examiner is affirmed.

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